

**REMARKS:**

Claims 1-27 are currently pending in the application. Claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,329,619 to Page et al. ("Page"). Claims 2, 13, 15, and 26 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent Application Publication No. 2002/0023037 A1 to White, Jr. ("White"). Claims 5 and 18 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent Application Publication No. 2003/0121000 A1 to Cooper et al. ("Cooper"). Claims 8 and 21 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent No. 6,381,579 to Gervais et al. ("Gervais"). Claims 9, 11, 12, 22, 24, and 25 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent No. 5,926,636 to Lam et al. ("Lam").

**ABSTRACT OBJECTION UNDER MPEP § 608.01(b):**

The Examiner objects to the Abstract because it exceeds 150 words under MPEP § 608.01(b). The Applicants have replaced the Abstract as suggested by the Examiner. Thus, the Applicants respectfully request that the objection to the abstract be reconsidered.

**CLAIM OBJECTION:**

The Examiner objects to claims 5 and 18 as being improper for using the trademark JAVA and requests the Applicants to replace the trademark JAVA with equivalent descriptive language. The Applicants have amended claims 5 and 18 as suggested by the Examiner. The Applicants respectfully submit that the equivalent descriptive language is described in the specification at page 3, line 31; page 7, lines 23-24; and page 10, line 5. No new matter has been added. Thus, the Applicants respectfully request that the objection to claims 5 and 18 be reconsidered and that claims 5 and 18 be allowed.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b):**

Claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,329,619 to Page et al. ("Page").

Although Applicants believe claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27 are directed to patentable subject matter without amendment, Applicants have amended claims 1, 3, 14, 16, and 27 to more particularly point out and distinctly claim the Applicants invention. These amendments are not considered narrowing or necessary for patentability. By making these amendments, Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 102(b), as set forth in the Office Action.

The Office Action alleges that Page discloses the claimed features of claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27, however, Page fails to disclose each and every limitation recited by claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27. Thus, Applicants respectfully assert that claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27 patentably distinguish over Page.

For example, with respect to amended claim 1, this claim recites:

A computer-implemented system, comprising:

a request broker, implemented as a component within a hub system, operable to:

receive a network API request component from a client, located remote from the hub system, the network API request component comprising a description of a system API method to be called and one or more parameters to be used in executing the system API method, the parameters having one of a plurality of acceptable native formats;

determine the native format of the parameters; and

communicate the parameters in the native format to a selected one of a plurality of translators for translation of the parameters from the native format to an internal format, each translator being associated with a different native format; and

communicate the parameters in the internal format to an application server to enable execution of the system API method according to the parameters; and

the application server system, operable to receive the parameters from the request broker in the internal format, generate a return value reflecting execution of the system API method according to the parameters, and communicate the return value to the request broker in the internal format;

the request broker further operable to receive the return value from the application server system in the internal format, communicate the return value in the internal format to the selected translator for translation of the return value from the internal format to the native format, generate a network API reply component that comprises the description of the system API method that was called and the return value in the native format, and communicate the network API reply component to the client. (Emphasis Added).

Amended independent claims 14 and 27 recite similar limitations. Page fails to disclose each and every limitation of amended independent claims 1, 14, and 27.

For example, Page fails to disclose a request broker implemented as a component within a hub system. Although Page discloses a service broker that manages requests by participants for services (Figure 2, element 14), Page does not disclose the management of requests made by participants within a hub system. Thus, Page does not provide a request broker or even a service broker implemented as a component within a hub system. Page also fails to disclose a request broker receiving a network application program interface component from a client, located remote from the hub system. As mentioned above, Page does not disclose the service broker implemented as a component with a hub system. Thus, Page cannot receive a network application program interface from participants that are remote from the service broker for service requests since the service broker is not implemented within a hub system.

The Applicants further submit that Page does not disclose determining or communicating the native format of the parameters to at least one translator for translation of the native format of the parameters to an internal format. Although Page discloses a translation service that may be used for different data formats; it is only contemplated for use provided a suitable translation routine is available, (column 46, lines 59-67), Page

does not determine or communicate the native formats or even the different data formats to an internal format within a selected one of a plurality of translators.

Thus, the allegation in the present Office Action that Page discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how Page is considered to anticipate all of the limitations in amended independent claim 1. A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference. MPEP § 2131. Applicants respectfully point out that "it is incumbent upon the [E]xaminer to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicants respectfully submit that the Office Action has failed to establish a prima facie case of anticipation in amended independent claim 1 under 35 U.S.C. § 102 with respect to Page because Page fails to identically disclose each and every element of the Applicants claimed invention, arranged as they are in Applicants claim.

With respect to amended independent claims 14 and 27 each of these claims includes limitations similar to those discussed above in connection with amended independent claim 1. Therefore, amended independent claims 14 and 27 are considered patentably distinguishable over Page for at least the reasons discussed above in connection with amended independent claim 1.

With respect to dependent claims 3, 4, 6, 7, 10, 16, 17, 19, 20, and 23, claims 3, 4, 6, 7, and 10 depend from amended independent claim 1, and claims 16, 17, 19, 20, and 23 depend from amended independent claim 14. As mentioned above, each of amended independent claims 1, 14, and 27 is considered patentably distinguishable over Page. Thus, dependent claims 3, 4, 6, 7, 10, 16, 17, 19, 20, and 23 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for the reasons set forth herein, the Applicants submit that claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27 are not anticipated by Page. The Applicants further submit that claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27 are in condition for

allowance. Therefore, the Applicants respectfully request that the rejection of claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27 under 35 U.S.C. § 102(b) be reconsidered and that claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27 be allowed.

#### **THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:**

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.
5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.
6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.



**REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 2, 13, 15, and 26 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent Application Publication No. 2002/0023037 A1 to White, Jr. ("White"). Claims 5 and 18 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent Application Publication No. 2003/0121000 A1 to Cooper et al. ("Cooper"). Claims 8 and 21 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent No. 6,381,579 to Gervais et al. ("Gervais"). Claims 9, 11, 12, 22, 24, and 25 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent No. 5,926,636 to Lam et al. ("Lam").

The Applicants respectfully submit that Page or White either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 2, 13, 15, or 26. The Applicants further submit that Page or Cooper either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 5 or 18. The Applicants still further submit that Page or Gervais either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 8 or 21. Furthermore, the Applicants respectfully submit that Page or Lam either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 9, 11, 12, 22, 24, and 25. Thus, the Applicants respectfully traverse the Examiners obvious rejection of claims 2, 5, 8, 9, 11, 12, 13, 15, 18, 21, 22, 24, 25, and 26 under 35 U.S.C. § 103(a) over the proposed combination of White, Cooper, Gervais, and Lam either individually or in combination with Page.

Claims 2, 5, 8, 9, 11, 12, and 13 depend from amended independent claim 1 and claims 15, 18, 21, 22, 24, 25, and 26 depend from amended independent claim 14. Since each of amended independent claims 1 and 14 are considered to be in condition for allowance as discussed above, claims 2, 5, 8, 9, 11, 12, 13, 15, 18, 21, 22, 24, 25, and 26 are considered to be in condition for allowance for at least the fact that they depend from an allowable claim. In addition, claims 2, 5, 8, 9, 11, 12, 13, 15, 18, 21, 22, 24, 25, and 26 set forth additional subject matter that is considered to be patentably distinguishable over the prior art as discussed below.

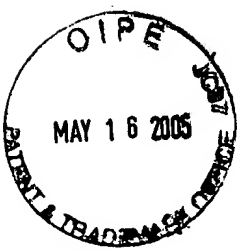
The Applicants submit that the Office Action acknowledges that Page fails to disclose the limitations cited in dependent claims 2, 5, 8, 9, 11, 12, 13, 15, 18, 21, 22, 24, 25, and 26. The Applicants further submit that White, Cooper, Gervais, and Lam do nothing to overcome the acknowledged shortcomings in Page. For example, White fails to disclose a request broker, implemented as a component within a hub system, operating at a Secure Hypertext Transport Protocol (HTTPS) web server. White further fails to disclose a client initiating a connection through at least one port of the system firewall to communicate with a request broker, implemented as a component within a hub system. The Applicants further submit that Cooper fails to disclose a request broker, implemented as a component within a hub system, having a plurality of acceptable native formats comprising Extensible Markup Language (XML), Electronic Data Interchange (EDI), and serialized object formats. The Applicants still further submit that Gervais fails to disclose an application server system, operable to receive the parameters from a request broker, implemented as a component within a hub system, comprising at least a collaborative planning application operable to provide planning data for one or more clients, located remote from the hub system.

The Applicants submit that Lam fails to disclose a request broker, implemented as a component within a hub system, operable to receive a network API request component and generate a network API reply component each comprising a version identifier indicating the version of the network component being used. Lam further fails to disclose the network API reply comprising a deprecation notice indicating to the client, located remote from the hub system, that the system API method called should not be further used. Lam still further fails to disclose a request broker, implemented as a component within a hub system, further operable to generate a network API exception component received from a second client, located remote from the hub system, comprising a description of the exception, and a deprecation notice indicating to the second client that the second system API method called should not be further used. The Applicants respectfully traverse the Examiners assertions regarding the subject matter disclosed in White, Cooper, Gervais, and Lam.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness. The Office Action merely states that portions of the claimed invention would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the teachings of the prior art into Page. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of White, Cooper, Gervais, and Lam with Page.

With respect to dependent claims 2, 5, 8, 9, 11, 12, 13, 15, 18, 21, 22, 24, 25, and 26, claims 2, 5, 8, 9, 11, 12, and 13 depend from amended independent claim 1 and claims 15, 18, 21, 22, 24, 25, and 26 depend from amended independent claim 14. As mentioned above, each of amended independent claims 1 and 14 are considered patentably distinguishable over the proposed combination of White, Cooper, Gervais, and Lam with Page. Thus, dependent claims 2, 5, 8, 9, 11, 12, 13, 15, 18, 21, 22, 24, 25, and 26 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For the reasons set forth herein, the Applicants submit that claims 2, 13, 15, and 26 are not rendered obvious by the proposed combination of Page and White; claims 5 and 18 are not rendered obvious by the proposed combination of Page and Cooper; claims 8 and 21 are not rendered obvious by the proposed combination of Page and Gervais; and claims 9, 11, 12, 22, 24, and 25 are not rendered obvious by the proposed combination of Page and Lam. The Applicants further submit that claims 2, 5, 8, 9, 11, 12, 13, 15, 18, 21, 22, 24, 25, and 26 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 2, 5, 8, 9, 11, 12, 13, 15, 18, 21, 22, 24, 25, and 26 under 35 U.S.C. § 103(a) be reconsidered and that claims 2, 5, 8, 9, 11, 12, 13, 15, 18, 21, 22, 24, 25, and 26 be allowed.



### **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.


Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

**Please link this application to Customer No. 38441 so that its status may be checked via the PAIR System.**

Respectfully submitted,

9 MAY 2005

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